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REMARKS

This is a full and timely response to the final Official Action mailed May 2, 2005 and the Advisory Action of August 3, 2005. A petition for a one-month extension of time to respond to the final Office Action, along with the appropriate fee, is filed herewith. Consequently, reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Request for Continued Examination:

Applicant hereby requests Continued Examination for this application. Applicant further requests that the after-final amendment of June 28, 2005 be entered in connection with this Request for Continued Examination. The preceding claim listing presumes previous entry of the after-final amendment of June 28, 2005.

Status of Claims:

Claims 1, 6-10, 13-17, 20 and 21 have been cancelled previously. New claims 32 and 33 have been added herein. Consequently, claims 2-5, 11, 12, 18, 19 and 22-33 are currently pending for further action.

Prior Art -- § 102:

In the final Action, claims 1-21 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,579,446 to Naik et al. ("Naik"). For at least the following reasons, this rejection is respectfully traversed.

Claim 2 recites:

A printer driver stored on a computer-readable medium comprising:
an interface configured to receive print job data;

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a print job formatting routine which notes one or more regions within a print job derived from said print job data and further specifies a particular print quality level at which each such region is then printed;

a WYSIWYG display routine for generating a WYSIWYG display of said print job; and

a user input routine for receiving user input defining said one or more regions within said print job using said WYSIWYG display, wherein said user input can selectively define any portion of said print job as a said region with a specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.

(emphasis added).

Independent claims 11, 18 and 25 all recite the highlighted subject matter.

In contrast, Naik does not teach or suggest a user input routine or method step for receiving user input defining one or more regions within a print job “wherein said user input can selectively define any portion of said print job as a said region with a specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.”

Naik at Fig. 5, for example, teaches that text, graphics and photos are recognized by the system and may be printed using different techniques. Naik implies that these elements are automatically recognized by the system and then printed accordingly. (Naik, col. 5, lines 26-29). Naik never teaches or suggests that a user input routine receives user input that defines one or more regions within a print job as desired by a user.

The recent final Office Action refers to Naik at Figs. 2 and 3 as allegedly showing “that a user may define text, graphics and photo regions of a document.” (Action of 5/2/05, p. 10, sec. 7). This is incorrect. These figures show different elements, such as text and graphics, that are combined into a document. But, the cited figures do not teach or suggest that a user does or is able to define a region within the print job. Fig. 5 further makes clear that the user is merely adjusting settings for pre-defined classes of objects, such as text,

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graphics and photos. The user has no option to define what a region is or what a region contains as in Applicant's claims.

This is significant because the Naik system will treat all graphics alike, all text alike and all photos alike. In contrast, the system described and claimed by the Applicant allows a user to define any regions the user desires. Consequently, two photographs can be designated as different regions and treated differently. A region can be defined to include both text and a photo or graphic. These features are not possible with the Naik system and highlight the fact that Naik does not teach or suggest the claimed "user input routine" through which user input defines the regions within a print job that are printed at different quality levels.

Additionally, Naik does not teach or suggest the claimed WYSIWYG display. As defined in Applicant's specification, "WYSIWYG stands for What You See Is What You Get. The WYSIWYG illustration is intended to show the user precisely what the print job will look like when printed." (Applicant's specification, paragraphs 0042-0043).

Thus, a WYSIWYG display, as claimed, is not merely a representation of the document to be printed, as shown in Naik's Fig. 2A, but is a representation of precisely what the print job will look like when printed. The Advisory Action assumes without support in the Naik reference that the display in, for example, Naik's Fig. 2A, is a WYSIWYG display. However, Naik does not ever teach or suggest that the display is a WYSIWYG display. Thus, the Advisory Action is reading teachings into Naik that are not actually there.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, for at least this reason, the

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rejection of claims 2, 11 and 18 and their respective dependent claims based on Naik should be reconsidered and withdrawn.

Claim 5 recites:

The printer driver of claim 4, wherein said user input routine is configured to display movement of a cursor on said WYSIWYG display in response to physical movement of said mouse, said movement of said cursor being used by said user input routine to define said one or more regions within said print job. (emphasis added).

Claim 12 similarly recites: "The method of claim 11, further comprising specifying said one or more regions within said print job by moving a cursor driven by a mouse over said WYSIWYG display."

In contrast, Naik does not teach or suggest a mouse operating a cursor where the movement of the cursor defines one or more regions within a print job that are treated differently as claimed. *The final Office Action fails to indicate how or where this subject matter is taught or suggested by the prior art of record.* For at least this additional reason, the rejection of claim 5 should be reconsidered and withdrawn.

Prior Art -- § 103:

Claims 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Naik and U.S. Patent No. 6,107,113 to Nicoloff Jr., et al. ("Nicoloff"). This rejection is respectfully traversed for at least the same reasons given above with respect to the independent claims from which claims 22-24 respectively depend.

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Claims 25-27 and 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Naik and Kamasak (of record). For at least the following reasons, this rejection is respectfully traversed.

Claim 25 recites:

A printer driver stored on a computer-readable medium comprising:
an interface configured to receive print job data;
a user interface with which a user designates one or more specific regions of a print job represented by said print job data; and
a print job formatting routine which notes said one or more regions within said print job and further specifies a particular print quality level at which each such region is then printed,
wherein user input through said user interface can selectively define any portion of said print job as a said region with a specified print quality level, said regions including or excluding any particular element or elements of said print job as desired by a user.

(emphasis added).

In making this rejection, the final Office Action states that "Naik teaches a user interface with which a user designates one or more specific regions." (Action of 5/2/05, p. 8). As demonstrated above, this is incorrect. Naik does not ever teach or suggest that a user designates specific regions. Rather, the various elements of a print job are automatically identified to the user and printing techniques to be used on those regions are then selected. (Naik, col. 5, lines 26-33). The user of the Naik system does not designate specific regions of the print job as claimed.

Similarly, Kamasak does not teach or suggest a user interface in which a user designates one or more specific regions of a print job. Rather, Kamasak merely states that the described system "[s]egments the document into regions that require different print modes." (Kamasak, p. 4). Kamasak does not ever teach or suggest that this segmentation is based on user input through a user interface that designates specific regions.

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"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claim 25 and its dependent claims should be reconsidered and withdrawn.

Moreover, Applicant notes that Kamasak is not valid prior art as against the present application. Kamasak was published sometime between Sept. 30, 2001 and October 5, 2001. The present application was filed contemporaneously on October 11, 2001. However, the Applicant invented the present subject matter well prior to the publication date of the Kamasak reference and then diligently pursued the filing of the present application.

The undersigned hereby declares under 37 C.F.R. § 1.132 that documents in the possession of the undersigned show that Applicant fully described and enabled the subject matter now claimed in the present application prior the publication of the Kamasak reference. Consequently, the Kamasak reference is not valid prior art as against the present application. For at least this additional reason, the rejection of claim 25 and its dependent claims should be reconsidered and withdrawn.

The Advisory Action holds that "a proper 1.132 declaration has not been made. . . . The declaration is not supported by any evidence." (Advisory Action of 8/3/05). This is incorrect. As made clear in MPEP § 716, the declaration is itself evidence as written testimony of the facts declared. Consequently, reconsideration of the undersigned's declaration and withdrawal of the Kamasak reference is respectfully requested.

Claim 28 was rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Naik, Kamasak and Nicoloff. This rejection is respectfully traversed for at least the same reasons given above with respect to claim 25, from which claim 28 depends.

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Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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